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EXAMINER	
CHAMPAGNE, DONALD	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/298,763	WOOD ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2006* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 April 1999* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment Filed After BPAI Decision

1. As applicant notes (p. 11 of the amendment filed on 27 November 2006), the BPAI reversed the rejection of independent claim 32 and its dependent claims because the BPAI did not find support for the alleged teaching of a limitation of claim 32 by Jovicic et al. See p. 17 of the BPAI decision filed on 25 September 2006. Applicant accordingly amended the claims to incorporate the limitation of claim 32 found to be wanting by the BPAI.

2. The subject limitation for all of the independent claims except claim 32 is in fact taught by the reference (as the *browsing memory **128***, at col. 6 lines 11-13, which was not previously cited by the examiner). Accordingly, a new non-final rejection follows. New prior art has been applied to reject claim 32 and its dependent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At claim 1 line 13, "said reward indicator identifying a promotional incentive" is indefinite because it appears to confuse reward "indicator" with reward "identifier". This rejection can be overcome by amending claim 1 line 13, to read, "said reward ~~indicator~~ identifier identifying a promotional incentive".

Claim Rejections - 35 USC § 102 and 35 USC § 103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1, 5-13, 16-22, 24, 25 and 38 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as unpatentable over Jovicic et al. (US005855007A).

8. Jovicic et al. teaches (independent claims 1, 17, 19, 20 and 38) a computer- implemented method and system for interactively and electronically distributing and redeeming rewards, the method comprising:

displaying a graphic of an electronic coupon (col. 8 line 10-11 and col. 6 lines 49-55), which reads on an advertising image and a promotional incentive, comprising a reward indicator and a reward identifier[1], on a computer screen of a local computer (*Internet node **102***, col. 7 lines 41-43), wherein the local computer is coupled to a computer network (col. 5 lines 24-26);

enabling a user to select the image (col. 8 lines 10-11);

at a central location (*Internet Coupon Server **124***) coupled to the computer network (col. 6 lines 4-5), seamlessly determining the identity of the user (col. 2 lines 49-52) when said image is selected;

at the central location, automatically allocating a reward associated with the advertising image when said image is selected (inherently, because the advertising/*electronic coupon **302*** comprises a reward[1]), wherein said allocating step includes storing a reward identifier

[1] To one of ordinary skill in the art, "advertising" is anything that promotes. A coupon is a kind of incentive or "promotional incentive". In this case the coupon describes the product being promoted and the promoter/advertiser (*owner*, col. 6 lines 49-55), so it advertises both the product and its promoter/ advertiser. The coupon includes *discount information **302***, which reads on a "reward indicator". "Reward identifier" does not appear to be disclosed in the specification; it is interpreted as synonymous with coupon ID (taught as *coupon serial number **318***).

(*coupon serial number **318***) with the identity of the user (*customer's/user's name data **320***, col. 7 lines 24-40) in a central database (*coupon data base **130***, col. 8 lines 48-49), said reward indicator (presumably this means reward "identifier") identifying a promotional incentive, said central database being accessible by the user enabling the user to view a list of rewards (in *browsing memory **128***, col. 6 lines 11-13) that have been allocated to the user and enabling the user to select a reward for redemption from the list of rewards.[2]

9. For independent claim 19, the two clauses beginning with "if" are not effective claim limitations (MPEP § 2111.04).

10. Jovicic et al. also teaches (claim 20), without pre-registration of a (new) user, where pre-registration is interpreted as registration before the present online session.

11. Jovicic et al. does not explicitly teach that the purpose of the method and system is increasing the click-through rate for advertisements/to attract traffic to a promoter computer. However, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the purpose of all advertising is product promotion, of which targeted promotion distribution is an important element. Success is measured by the number of coupons that are selected and used, which reads on increasing the click-through rate for electronic coupons/advertisements or attracting traffic to the promoter computer. Alternatively, because promotion success is commonly measured by increases in click-through rate, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Jovicic et al. that the method and system be practiced to increase the click-through rate for advertisements/to attract traffic to a promoter computer.

12. Jovicic et al. also teaches at the citations given above claims 5, 6 and 25. The reference also teaches claims 7, 22 and 24 (col. 3 line 27); claims 8-11 and 18 (col. 3 line 13 and col. 6 line 54); claim 12 (col. 6 line 51); claim 16 (col. 2 line 44) and claims 21 (col. 7 lines 12-14). The reference also teaches claim 13 inherently as the home page of the Internet Coupon Server (col. 6 lines 5-6).

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[2] The "optional" limitations at the end of claims 1 and 6 are ignored because "optional" claim language is not an effective limitation (MPEP § 2111.04).

13. Claims 2-4, 14-15, 23, 26-31 and 39 are rejected under 35 USC 103(a) as obvious over Jovicic et al.

14. Jovicic et al. does not teach (claims 2-4 and 23) storing the user ID number in a cookie/local computer datafile. Because cookies were well-known user conveniences, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add storing the user ID number in a cookie/local computer datafile to the reference invention.

15. Jovicic et al. does not teach (claims 26-31) the user device limitations of these claims (ATM, PDA, etc.). However, the user does teach the genus *general-purpose digital computer* and a PC (col. 5 lines 26 and 41-42). Because the claimed devices were well known and convenient user computers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add these user computers to the reference invention.

16. Jovicic et al. does not teach (claims 14-15) ID input by magnetic stripe or smart card. Because this is an inherent and convenient means for input with some of the obvious claimed user computers (e.g. ATM), it would have been inherent, or alternatively obvious to one of ordinary skill in the art, at the time of the invention, to input the ID by magnetic stripe or smart card.

17. Jovicic et al. does not teach (claim 39) means to transfer a reward to another registered user. Because this would be an attractive user feature easily implemented with the reference invention, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add means to transfer a coupon reward to another registered user to the teachings of Jovicic et al.

18. Claims 32-37 are rejected under 35 U.S.C. 103(a) as unpatentable over Jovicic et al. (US005855007A) in view of Narasimhan et al. (US006237145B1).

19. Jovicic et al. does teach (independent claim 32) a user computer coupled to the computer network (*Internet node **102***, col. 5 lines 24-26), the user computer enabling the user to select a reward for redemption from the list of rewards (in local storage, col. 8 lines 19-21) previously collected by the user and that are available for redemption. Jovicic et al. does not teach that said list of rewards is stored in a central computer database. Narasimhan et al. teaches that said list of rewards is stored in a central computer database (col. 6 lines 29-36). Because Narasimhan et al. teaches that server storage is more desirable than local

storage (col. 1 line 54 to col. 2 line 11), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Narasimhan et al. to those of Jovicic et al.

20. Jovicic et al. also teaches at the citations given above claims and 33-37.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

22. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for all *formal* fax communications is 571-273-8300.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

24. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

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14 April 2007

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